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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/999,604 12/26/96 DENT

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EXAMINER

LUTHER, W

ART UNIT

PAPER NUMBER

2664

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/999,604

Applicant(s)

DENT

Examiner

William Luther

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28 is/are allowed.
- 6) ☒ Claim(s) 29-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## BACKGROUND

This communication (instant file wrapper paper no. 25, i.e., #25<sup>ms</sup>) is issued in response to the communication which was filed on June 6, 2001 (#24<sup>ms</sup>), and its related two-month extension of time under 37 C.F.R. 1.136 (rule 136) (#23). The June 6, 2001, communication was filed in reply to the Office action that was issued on March 13, 2001 (#22). The March 13, 2001, Office action was issued in response to the communication which was filed on February 12, 2001 (#21). The February 12, 2001, communication was filed concurrent with a notice of appeal (#20) and a 2-month extension of time under rule 136 (#19). The February 12, 2001, communications were filed in reply to the Office action which was issued on September 12, 2000 (#18). The September 12, 2000, Office action was issued subsequent to the June 22, 2000, filing of the communication titled "Change of Address/Power of Attorney" (#17). Also, the September 12, 2000, Office action was issued in response to the communication which was filed on June 8, 2000 (#16). The June 8, 2000, communication was filed in reply to the notice which was issued on May 9, 2000 (#15). The May 9, 2000, notice was issued in response to the communication that was filed on February 24, 2000 (#14). The February 24, 2000, communication was filed in reply to the Office action which was issued on November 24, 1999 (#13). The November 24, 1999, Office action was issued subsequent to an information disclosure (#12) filed on August 30, 1999, and in response to an amendment (#11) which was also filed on August 30, 1999, concurrent with its rule 136 one month extension of time (#10). The August 30, 1999, amendment was filed in reply to the Office action which was issued on April 28, 1999 (#9). The

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April 28, 1999, Office action was issued in response to the amendment which was filed on February 4, 1999 (#8), which was filed concurrent with the rule 136 three month extension of time (#7). The February 4, 1999, Amendment was filed subsequent to the "letter" which was issued on August 5, 1998 (#6). The August 5, 1998 "letter" informed the applicant that applicant's "response to the office action mailed July 30, 1998 . . . [had] not been received . . ." (capitalization omitted). The August 5, 1998, "letter" was issued in response to the "status letter" which was filed on July 27, 1998 (#5). The "status letter" was apparently filed before and entered into the file wrapper after the July 30, 1998, issuance of the first Office action (#4) on the merits of this instant reissue application. The July 30, 1998, Office action was issued subsequent to the filing of the "statement under [rule] 3.73(b) and submission of documents showing name change" (capitalization omitted) which was filed on March 19, 1998 (#3). The statement under rule 3.73(b) was filed in reply to the issuance of the February 27, 1998, notice (#2) to the applicant to file certain missing parts of the instant reissue application. The February 27, 1998, notice was issued in response to the filing of the instant reissue application which was filed on December 26, 1996 (#1) under 35 U.S.C. 151 (section 151). The instant application is therefore subject to those related regulations including 37 C.F.R. 1.171 through 1.179. The instant reissue application is a reissue examination of U.S. Patent 5,377,183 ('183), which was issued on December 27, 1994. Patent '183 was issued from U.S. Patent Application 08/226,470 (Appl. '470), which was filed on April 11, 1994. Application '470, was a continuation application from its parent U.S. Patent Application 07/868,335 (Appl. '335) which was filed on April 13, 1992.

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**Appl. '470 file history:**

The most recent paper was filed on April 1, 1997 (paper no. 22, i.e., #22), is a "status inquiry" which states "[p]lease advise, in writing, as to the current status of [Appl. '470]." The April 1, 1997, "status inquiry" was filed subsequent to the December 27, 1994, issuance of U.S. Patent '183 (#21). Patent '183 was issued subsequent to the filing of formal drawings on September 13, 1994 (#20), and also subsequent to the notice of allowance which was issued on June 27, 1994 (#19). The June 27, 1994, notice of allowance was issued subsequent to the information disclosure which was filed on April 11, 1994 (#18), as well as the preliminary amendments "E" (#17) and "D" (#16) which were also filed on April 11, 1994. The June 27, notice of allowance was issued in response to the filing of Appl. '470, on April 11, 1994. It appears that the application '470 purports priority benefit to its parent application '335 under section 120.

**Appl. '335 file history:**

The applicant was issued a notice of abandonment on May 26, 1994 (#15). The May 26, 1994, notice was issued subsequent to the notice of appeal which was filed by the applicant on February 9, 1994 (#14). The February 9, 1994, notice of appeal was filed concurrently with a rule 136 one month extension of time (#13). The February 9, 1994, notice of appeal was filed in reply to the advisory action which was issued on February 4, 1994 (#12). The February 4, 1994, action was issued in response to the amendment which was filed under 37 C.F.R. 1.116 on January 12, 1994 (#11). The January 12, 1994, amendment was currently filed with a rule 136 two month

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extension if time (#10), and in reply to the Office action which was issued on August 9, 1993 (#9). The August 3, 1993, Office action was issued in response to the amendment which was filed on May 19, 1993 (#8), and subsequent to the information disclosure which was filed on February 23, 1993 (#7). The May 19, 1993, amendment was filed in reply to the Office action which was issued on February 19, 1993 (#6). The February 19, 1993, Office action was issued subsequent to the filing of an information disclosure on July 10, 1992 (#5), a preliminary amendment which was also filed on July 10, 1992 (#4), and a declaration which was filed on June 10, 1992 (#3). The June 10, 1992, declaration was filed in reply to the related notice (which required the filing of such a declaration) which was issued on May 11, 1992 (#2). The May 11, 1992, notice was issued in response to the filing of Appl. '335, on April 13, 1992.

The applicant seeks a reissue of the U.S. Patent '183 under section 151, which was filed on April 11, 1994. It also appears that the applicant claims priority benefit under 35 U.S.C. 120 (section 120) to Appl. '335, and thus apparently desires an effective filing date of April 13, 1992. The instant reissue application was filed within two years of the issuance of U.S. Patent '183, and thus the applicant is not barred from reissued claims which are broader in scope than those claims of the issued U.S. Patent '183, with the exception of limitations related to "surrender and recapture" preclusion.

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By preponderance of the evidence in view of the above related prosecution history in the manner provided for under In re Oetiker 977 F.2d 1442 (Fed. Cir. 1992) , the examiner cannot conclude that the pending reissue claims satisfy the requirements of 35 U.S.C. 151 in that it appears that there are specific limitations that cannot be omitted from the reissue claims under “surrender and recapture” preclusion.

1. Claims 29-44 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.


Considering new claims 29 and 33 (corresponding to the prosecution of the patent's claims 1 and 24), as well as new claims 30-32 and 34-44, those limitations identified by the applicant in

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the declaration filed on March 19, 1998 (page 2 paragraph (6)) as being "deleted" relate to subject matter that appears to have been "surrendered" during the prosecution of the patent (e.g., the subject matter which was apparently surrendered by applicant in the after final amendment which was filed on January 12, 1994, and later entered by right when the '470 application was subsequently filed on April 11, 1994.) Moreover, it appears that these apparently "surrendered" limitations should be included in each of the new claims presented for reissue (claims 30-32 and 34-44). Should the applicant disagree, a detailed legal analysis providing justification for such a position is encouraged, providing case law specifically pertinent whenever possible. The applicant should also be specifically clear if and how he may be challenging Federal Circuit precedent.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Luther whose telephone number is (703) 308-6609.

William Luther  
Primary Examiner  
August 27, 2001

A handwritten signature in black ink, appearing to read 'W. Luther', with a large, stylized flourish at the end.